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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,978	08/31/2001	Ken Kutaragi	100809-16279 (SCEW) 18.968	7677
26304 7590 08/20/2008 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER VAN HANDEL, MICHAEL P	
			ART UNIT	PAPER NUMBER
			2623	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/942,978	Applicant(s) KUTARAGI ET AL.	
	Examiner MICHAEL VAN HANDEL	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 06 June 2008.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-8 is/are pending in the application.

 4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-8 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/06/2008 has been entered.

Response to Amendment

1. This action is responsive to an Amendment filed 6/06/2008. Claims **1-8** are pending. Claims **1, 2, 4, 6, 7** are amended. Claims **9-12** are canceled.

Response to Arguments

1. Applicant's arguments regarding claims **1, 2, 4, 6, and 7**, filed 6/06/2008, have been fully considered, but they are not persuasive.

Regarding claims **1, 2, 4, 6, and 7**, the applicant argues that Stefik et al. fails to disclose or suggest digital information itself including functionality. The examiner respectfully disagrees. As noted in the Advisory Action mailed 5/09/2008, Stefik et al. discloses attaching metering rights to a digital work (col. 10, l. 58-64; col. 22, l. 51-56; col. 23, l. 13-26; col. 25, l. 35-38; & col. 26, l. 61-65). An End-charges transaction ends a charge for metered use. A report-charges transaction between a personal credit server and a billing clearinghouse is invoked at least once

per billing period, and is used to pass along information about charges (col. 31, l. 26-40). The examiner notes that the metering rights do provide functionality to the credit server to autonomously monitor the utilization of contents, because the clock in the credit server would not monitor the time usage of contents if metered usage rights were not set. Applicant specifically argues that the above is still just a simple causation, and that the “metering and clock functions” taken from Stefik et al. rely upon secure entities, such as repositories, to separately include secure functionality for performing enforcement functions. The applicant further specifically argues that the usage rights, at most, include parameters defining how the digital work may be used or further distributed as enforced by the secure functionality provided by the enforcement elements. The applicant still further specifically argues that the usage rights do not themselves include any functionality, but they merely call functions already defined in the entities that refer to those usage rights for performing functions according to parameters defined in the usage rights. The examiner notes; however, that the metering rights “function” to call these functions and further “function” to cause the metering and clock functions to occur in the credit server. As such, the examiner maintains that the metering rights of Stefik et al. include functionality provided to the user terminal, as currently claimed.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims **1, 6** are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al.

Referring to claims **1** and **6**, Stefik et al. discloses a method/system/computer program for managing fees of contents in which the fees arise based on a predetermined charging rule upon distributing the contents (col. 4, l. 4-10), said method/system comprising the steps of:

- equipping information gathering means on a network (Billing Clearinghouse) with which a user terminal (computer system) is allowed to connect (col. 7, l. 5-37), said user terminal carrying out information processing by utilizing said contents (col. 7, l. 66-67; col. 8, l. 1-18, 57-67; col. 9, l. 1-5; & Figs. 3, 4b);
- embedding digital information to said contents (col. 7, l. 7-10; col. 10, l. 8-11; & col. 11, l. 44-52), said digital information itself including functionality provided to said user terminal to autonomously monitor, and store, a contents utilizing history at the user terminal (col. 22, l. 51-56; col. 23, l. 13-26; col. 25, l. 35-38; col. 26, l. 61-65; col. 31, l. 26-40; col. 33, l. 53-57; & col. 50, l. 26-28), and transmit the stored contents utilizing history along with identification information (col. 31, l. 16-18, 37-41) to said information gathering means at a predetermined timing while said user terminal is connected with said network (col. 8, l. 10-20, 57-67; col. 9, l. 1-5; col. 18, l. 12-45; & Fig. 3);
- distributing said contents with said digital information being embedded through a predetermined distribution mechanism (col. 4, l. 4-8; col. 10, l. 8-11; col. 11, l. 31-56; col. 22, l. 20-27; col. 45, l. 20-67; col. 46, l. 1-67; col. 47, l. 1-67; & col. 48, l. 1-45);
- holding, by predetermined identification information holding means, identification information for identifying said distributed contents and said distribution mechanism

- (col. 8, l. 4-9; col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 17, l. 48-67; & col. 18, l. 1-45);
- counting a distribution condition of contents per distribution mechanism based on said contents distributing history gathered through said information gathering means and said identification information held by said identification information holding means (col. 10, l. 8-11, 24-34, 45-67; col. 11, l. 1-13; col. 47, l. 30-45; & Fig. 14); and
 - determining a charging amount per distribution mechanism based on said counted distribution condition and a charging rule for said contents (col. 17, l. 48-60; col. 18, l. 1-45, 60-65; col. 32, l. 66-67; col. 33, l. 1-9; & col. 47, l. 30-45),
 - wherein the contents utilizing history is stored permanently as long as the contents is utilized (col. 10, l. 58-65; col. 14, l. 40-44; & col. 33, l. 53-57).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims **2-5, 7, and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al. in view of Aras et al.

Referring to claims 2, 4, and 7, Stefik et al. discloses a method/system for managing fees of contents in which the fees arise based on a predetermined charging rule upon utilizing the contents, said method comprising the steps of:

- issuing a recording medium to a user operating a user terminal which carries out information processing by utilizing said contents (col. 17, l. 31-36 & col. 18, l. 24-38), said recording medium having a data recording area in which user identification data is recorded (col. 13, l. 51-54, 59-67) and a memory area (col. 14, l. 28-39);
- equipping information gathering means on a network with which said user terminal with said recording medium being loaded is allowed to connect (col. 7, l. 5-37);
- embedding digital information to said contents, said digital information itself including functionality provided to said user terminal to autonomously monitor, and store to said memory area, a contents utilizing history indicating utilizing condition of the contents at the user terminal (col. 22, l. 51-56; col. 23, l. 13-26; col. 25, l. 35-38; col. 26, l. 61-65; col. 31, l. 26-40; col. 33, l. 53-57; & col. 50, l. 26-28), and read said stored contents utilizing history so as to transmit said contents utilizing history to said information gathering means along with said user identification data at a predetermined timing while said user terminal is connected with said network (col. 8, l. 4-9, 10-20, 57-67; col. 9, l. 1-5; col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 17, l. 48-67; col. 18, l. 1-45; & Fig. 3);
- distributing said contents with said digital information being embedded through a predetermined distribution mechanism (col. 4, l. 4-8; col. 10, l. 8-11; col. 11, l. 31-56; col. 22, l. 20-27; col. 45, l. 20-67; col. 46, l. 1-67; col. 47, l. 1-67; & col. 48, l. 1-45);

- holding, by predetermined identification information holding means, identification information for identifying said distributed contents and said distribution mechanism (col. 8, l. 4-9; col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 17, l. 48-67; & col. 18, l. 1-45);
- counting a utilization condition of the contents per user based on the contents utilizing history and the user identification data gathered through said information gathering means (col. 10, l. 8-11, 24-34, 45-67; col. 11, l. 1-13; col. 47, l. 30-45; & Fig. 14); and
- determining a charging amount per user based on said counted utilization condition and a charging rule for said contents (col. 17, l. 48-60; col. 18, l. 1-45, 60-65; col. 32, l. 66-67; col. 33, l. 1-9; & col. 47, l. 30-45),
- wherein the contents utilizing history is stored permanently as long as the contents is utilized (col. 10, l. 58-65; col. 14, l. 40-44; & col. 33, l. 53-57).

Stefik et al. does not specifically disclose that the memory area of the data recording area be a nonvolatile memory area. Aras et al. discloses a method and apparatus for monitoring audio-visual materials presented to a subscriber (col. 6, l. 32-52). Monitored audio-visual information is stored in a Behavior Collection Table (BCT)(col. 9, l. 2-11). The BCT table is stored to a non-volatile memory, such as a flash memory (col. 16, l. 46-49). The collected information is then sent to a Behavior Collection Center (BCC) for processing (col. 12, l. 40-54). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the memory of Stefik et al. to be a non-volatile memory, such as that taught by Aras et al. in order to retain data in a power off event (col. 16, l. 34-49).

Referring to claims **3** and **5**, the combination of Stefik et al. and Aras et al. teaches a method for managing fees of contents according to claims 2 and 4, respectively, further comprising the steps of encrypting the contents to be distributed and issuing key information for decrypting said encrypted contents, said key information being recorded in said recording medium (Stefik et al. col. 28, l. 1-37).

Referring to claim **8**, the combination of Stefik et al. and Aras et al. teaches a system for managing fees of contents according to claim 7, wherein said recording medium is a card equipped with an IC chip (col. 14, l. 7-50 & col. 17, l. 32-36), said card being individualized per user (col. 13, l. 51-67), and information indispensable for utilizing said contents is recorded in said card (col. 28, l. 28-30).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VAN HANDEL whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
Supervisory Patent Examiner, Art Unit
2623

MVH